

No. 15922

IN THE

**United States Court of Appeals**  
FOR THE NINTH CIRCUIT

---

EVEREST & JENNINGS, INC., a Corporation,

*Appellant,*

*vs.*

E. & J. MANUFACTURING COMPANY, a Corporation,

*Appellee.*

---

E. & J. MANUFACTURING COMPANY, a Corporation,

*Appellant,*

*vs.*

EVEREST & JENNINGS, INC., a Corporation,

*Appellee.*

---

**OPENING BRIEF FOR APPELLANT, EVEREST  
& JENNINGS, INC.**

---

FRANK H. MILLER,  
ALAN D. MOCKABEE,

By **FRANK H. MILLER.**

108 West Sixth Street,

Los Angeles 14, California,

Attorneys for Everest & Jennings, Inc.

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## OPENING BRIEF FOR APPELLANT, EVEREST & JENNINGS, INC.

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### Jurisdiction.

The plaintiff brought this suit for the infringement of its trademark "E & J" as applied to "resuscitators, oxygenators and cases especially designed and adapted to ship and carry said resuscitators and oxygenators." The trademark was registered in the United States Patent Office [Pltf. Ex. 1, R. 705.] There is a second count for unfair competition.

Jurisdiction of the Trial Court as to the claim of infringement of the registered trademark is conferred by both 28 USC 1338 and 15 USC 1121. Jurisdiction as to the unfair competition count is conferred by 28 USC 1338(b).

The defendant counterclaimed praying that the Court determine that the defendant had a right to use and to register the trademark "E-J" as applied to invalid wheel chairs. Jurisdiction of the counterclaim was conferred by 15 USC 1119 and 15 USC 1121.

The Appellate jurisdiction of this Court is obtained by 28 USC 1291 and 15 USC 1121.

#### Statement of the Case.

The plaintiff registered in the United States Patent office the trademark "E & J" as applied to "resuscitators, oxygenators and cases especially designed and adapted to ship and carry said resuscitators and oxygenators" [Pltf. Ex. 1, R. 705.] The application for this registration was filed May 29, 1947, and the registration certificate issued July 27, 1948.

The defendant manufactures and sells invalid wheel chairs and walkers but has never sold resuscitators or oxygenators or anything competitive therewith. Defendant's business was originally started in 1932, by Herbert A. Everest and Harry C. Jennings [R. 363, 375, 421] as copartners. Later, Everest & Jennings, Inc., the defendant named herein was incorporated and the assets of the partnership were transferred to the corporation. Everest has since sold out his entire interest in the corporation [R. 362.]

As the invalid wheel chair business grew during the years following 1932, defendant's invalid wheel chairs became known generally in the trade as "E & J chairs" or "E & J invalid wheel chairs." This terminology was adopted by the trade itself as a nickname for Everest & Jennings chairs or Everest & Jennings invalid wheel chairs. Plaintiff's witnesses and also defendant's witnesses so

testified. Defendant's witnesses Everest [R. 366, 369], Dunn [R. 413.] Plaintiff's witnesses Miller [R. 245-246], Williams [R. 533-534], Garrett [R. 556.] See also

Plaintiff's Exhibit 71, R. 731.

Defendant's Exhibit G, R. 771.

Defendant's Exhibit H, R. 733.

Because the trade and public generally were referring to defendant's products by the term "E & J", defendant, in 1946, proposed adopting the initials "E-J" as a trademark. Defendant had been subjected to rather strenuous wheel chair competition, see *Everest & Jennings, Inc. v. Duke*, 139 F. 2d 22 (CCA 7), certiorari denied, 321 U. S. 779, and feared that should competitors adopt and register the initials "E-J" or "E & J" as applied to invalid wheel chairs, that confusion in the trade would be extensive and at great loss to the defendant. A rather expensive die was procured in 1946 to cast the initials "E-J" on the metal footpads of the chair as a means of readily identifying defendant's wheel chairs as being of defendant's manufacture and standard of quality [R. 366-367, 382-383, 422.] Although each footpad carried the initials "E-J" each footpad also carried the full and complete name "Everest & Jennings" on the underside thereof [R. 377] see Defendant's Exhibit A, a physical exhibit. In addition thereto since 1946 each chair also carried a name plate on the X-brace bearing the name of the defendant in full, the street address of the defendant, and a serial number by which the chair could be identified [R. 377, 409.] Since December, 1952, the defendant in using the initials "E & J" has always had the full name of Everest & Jennings, Inc. somewhere in close proximity thereto [R. 388.]

The plaintiff claims to have been using the initials "E & J" on resuscitators since 1929 [Pltf. Ex. 1, R. 705.] This statement of first use in the certificate of registration is not strictly accurate because plaintiff, E & J Manufacturing Company, a corporation, the registrant, was not incorporated until December, 1945 [R. 681-682, 472.] The initials "E & J" of plaintiff's trademark were derived from the initials of the founders and developers of plaintiff's resuscitators, C. N. Erickson and Dr. Johnston [Request for Admission 66, R. 448.] Plaintiff claims to have derived title therefrom. Considerable doubt, however, exists as to whether plaintiff and plaintiff's predecessors actually used the trademark "E & J" or merely the firm name, "E & J Manufacturing Company," on their resuscitators. Thus, plaintiff's witness, Stanton, testified that Plaintiff's Exhibit 36 was used from 1933 to 1953 [R. 166.] This displays "E & J Manufacturing Co." not merely "E & J." The display of a company name has been repeatedly held not to be a trademark use of any part of it.

*I. & B. Cohen, Bomzon & Co., Inc. v. Biltmore, Industries, Inc.*, 22 USPQ 258;

*Duncan Electric Manufacturing Company v. Marzall*, 95 USPQ 242, 42 TM. Rep. 919;

*Minnesota Mining v. Minnesota Paint Co.*, 108 USPQ 314, 319, 229 F. 2d 448.

In a suit brought by plaintiff's predecessor for patent infringement, *Erickson, doing business as E & J Manufacturing Co. v. Emerson, doing business as J. H. Emerson Company, et al.*, 61 USPQ 42, 49 (apparently not reported elsewhere), decided in 1944 the name plate ap-

pearing on the front of the apparatus is rather meticulously described by the Trial Judge as consisting of a "plate 2½" x ½" with the legend in letters ½" high 'E & J Manufacturing Co.' and in smaller letters 'Glendale, California.'"

For a long period of time the parties to this litigation operated in complete ignorance of the other or its predecessor. Thus plaintiff's witness Stanton, who was engaged in the exploitation of the resuscitators of plaintiff and plaintiff's predecessor from 1933 to 1953, never even heard of the defendant or defendant's predecessor until 1946 [R. 142-143.] Plaintiff's witness Fox who entered Erickson's employ in 1928 [R. 674] never knew of defendant's existence until "\* \* \* 1945, or something like that." [R. 688-689.] Defendant's witness, Everest, never heard of plaintiff until he "\* \* \* happened to run into it in the phone book along about 1948." [R. 372.] This, in spite of the fact that both concerns were located within roughly fifteen miles of each other [R. 395.]

The plaintiff's goods are primarily resuscitators, oxygenators and allied equipment with prices ranging from \$350. to \$425. [R. 138] and sales were usually made only after a demonstration was made by a competent demonstrator [R. 138.] Usually, final decision to purchase one of plaintiff's resuscitators required the careful scrutiny and approval by someone in a medical capacity [R. 135.] As testified to by plaintiff's witness Stanton [R. 135]:

"\* \* \* all of our approach to any sales was medical, Mr. Miller, because the resuscitator is very much medical. It is not a lay apparatus, and no sale or no installation is ever made without the sanction of a group of doctors, prominent doctors

in any community, and every fire department has their medical advisors, and our approach to make a sale at the fire department was always through the hospital or a doctor who was in charge of the rescue service of the fire department."

Defendant's invalid wheel chairs, on the other hand, are sold at a much lower average figure and were sold to the general public or laity as well as to hospitals and institutions [R. 403.]

Despite the differences in the construction of resuscitators and invalid wheel chairs, the different use to which these are put, and the careful scrutiny given the plaintiff's resuscitators by someone of the "medical group" before plaintiff's resuscitators are purchased, the plaintiff contends that the use by the defendant of defendant's own initials "E-J" on its wheel chairs is an infringement of its trademark "E & J" as applied to resuscitators, oxygenators, and the like. In support of this contention plaintiff has produced evidence that can be classified in three categories:

(1) A mistake on the part of the publication Hospital Progress giving credit to Everest & Jennings for having developed a so-called "Resuscinette" (a resuscitator for use with infants) which was in fact developed by the plaintiff and not the defendant. [P. 94-A in Ex. 39.]

(2) Misaddressed mail containing purchase orders. [Ex. 47 transmitted as a physical exhibit.]

(3) Erroneous assumptions on the part of purchasing agents and others that when a person identifies himself or is introduced as being affiliated with "E & J" that he is connected with the defendant contrary to fact.

Discussing these in the order named, it is to be observed that no one affiliated with the publisher of Hospital Progress was a purchaser or prospective purchaser of defendant's wheel chairs, or of the plaintiff's resuscitators. For the magazine to give credit to the defendant for the development of the plaintiff's "Resuscinette" was an error, it is true—but it does not appear that this error was occasioned by reason of the defendant having used the initials "E-J" on its wheel chairs as its trademark, or by the defendant having advertised these initials in association with its true corporate name. How this error occurred, defendant has never been able to ascertain and plaintiff has offered no evidence other than the magazine itself. The error could have reasonably occurred by someone in the editorial department erroneously concluding that the true corporate name of the plaintiff E & J Manufacturing Company, was but a nicknaming of the corporate name of the defendant, Everest & Jennings, Inc., and that therefore, in giving credit to the developer of the "Resuscinette" the true name should be given. This was erroneously assumed to be Everest & Jennings, Inc., whose advertisement appears on the same page.

The error on the part of Hospital Progress, although aggravating, is nowhere shown to have resulted in any lost sales to the plaintiff or any gain in sales on the part of the defendant. Had the defendant received any orders for the "Resuscinette" defendant could not have filled them as it did not deal in any such articles or anything equivalent thereto. [R. 95.] Nor could have defendant palmed off a wheel chair as a substitute for the "Resuscinette" as alleged in paragraph 9 of count 2 of plaintiff's complaint [R. 9.]

There had been some misaddressed mail and purchase orders prior to the error committed by Hospital Progress in 1949 [R. 367, 384.] Some orders for defendant's goods were addressed and sent to the plaintiff by mistake. Conversely, some orders for plaintiff's goods were addressed and sent to the defendant by mistake. As neither party was dealing in the goods of the other and consequently could not fill such misaddressed orders, even if it wanted to, the practice was for each party to forward the misaddressed mail to the other party where the order properly belonged [R. 384-385.] This practice was indulged in regularly except where a more controlling reason required that it be returned to the sender [R. 395.] It is manifest, therefore, that no damage has been done the plaintiff and that there has been no palming off of defendant's goods as being those of the plaintiff [R. 199.]

The error on the part of Hospital Progress caused two meetings to be held between officials of the plaintiff and those of the defendant [R. 380-384] the result of which caused the defendant to propose deleting the use of E & J in reference to its wheel chairs in its advertising and in its correspondence in the hope that this would reduce or eliminate misaddressed mail [R. 365-367.] Plaintiff's Exhibit 40 [R. 707] was written to this effect. During the ensuing two years defendant's use of the initials "E-J" in its correspondence and advertising was discontinued [R. 384], but as misaddressed mail persisted, the use of the initials in advertising was resumed in 1952 [R. 386.]

There has been misdirected mail consisting mostly of purchase orders. In the case of plaintiff over half are for replacement parts [Request for admission 69, R. 448-449.]

The majority of these purchase orders come from surgical supply houses and identify the article wanted by its catalogue number—both parties having catalogues. As the article desired is usually so meticulously identified by its catalogue number, it is manifest that the person wishing the article in question or ordering the article must have had a catalogue available at the time that he decided to place his order. The catalogues of both parties carry their correct corporate names. In addition, the street address is displayed as well in the case of the defendant, but only the city address (Glendale or Burbank, California) in the case of the plaintiff. It would seem, therefore, that as the catalogue must have been before the person wishing to place the order, there is little excuse for the failure of the purchase orders being properly addressed. The only reasonable explanation in the case of surgical supply houses, is that the job of typing up and mailing the purchase orders was turned over to secretarial help or typists who assumed that orders for "E & J chairs" as abbreviations for Everest & Jennings chairs, should be sent to the E & J Manufacturing Company. Others who had occasion to type up orders for E & J resuscitators or oxygenators or parts thereof and who were familiar with Everest & Jennings chairs, erroneously assumed that such orders should be properly addressed to the defendant, Everest & Jennings, Inc. Plaintiff's witness, Miller, describes a typical practice in this regard at R. 248-250.

One of the worst offenders in misaddressing purchase orders was American Hospital Supply Corporation. American Hospital Supply Corporation owns Don Baxter, Inc. [R. 222, 454.] Don Baxter, Inc., in turn, owns E & J Manufacturing Co. [R. 222] so that in effect E & J

Manufacturing Company, the plaintiff herein, is a subsidiary of American Hospital Supply Corporation. One would think that American Hospital Supply Corporation would know what was manufactured and sold by its own subsidiary. However, a casual observation of Exhibit 47 transmitted as a physical exhibit shows that American Hospital Supply Corporation was a serious offender in misdirecting mail to both parties to this proceeding [R. 365, 366.]

In 1956, American Hospital Supply Corporation discontinued purchasing defendant's wheel chairs entirely [Deft. Ex. J, R. 778] probably because after American Hospital Supply Company made overtures to purchase the defendant [R. 428] it purchased another wheel chair company [R. 458.]

Considerable confusion was injected into the trial of this case by plaintiff's attorney's comments and by the comments of the Trial Judge, made during the trial as to what significance, if any these misaddressed letters and orders had [see R. 109-111; 407-409.] If as stated by the Trial Court at R. 409:

“\* \* \* where there is a piece of misdirected mail without the accompaniment of other evidence, I don't look upon it as evidence of anything else other than misdirected mail, which is not a determinative factor in this case.”

then, the evidence of misdirected mail has little if any bearing on the case. It has nowhere been established that whoever misdirected the mail was an actual or potential purchaser of the goods—as distinguished from merely secretarial help having no other interest in the transaction than to earn a living from her employer.

The third category presented by the plaintiff relates to erroneous assumptions made when representatives of the plaintiff introduce themselves as being affiliated with "E & J" instead of E & J Manufacturing Company. An example of this is as testified to by plaintiff's witness Miller at R. 244:

"\* \* \* I introduced John Dirmann (of plaintiff E & J Manufacturing Co.) to Mr. Hanner, and I said, 'This is the E & J's representative.'

"And he said, 'Ken, we aren't interested in buying wheelchairs right now.'"

Plaintiff's witness Dirmann tells substantially the same story [R. 313.]

Manifestly, if a man merely introduces himself or is introduced as an "E & J" man [R. 313], this could signify most anything. The plaintiff's name is not merely E & J but instead is E & J Manufacturing Company. If the introducer seeks to shorten the true name to merely E & J as a nickname he should be prepared to suffer the consequences of possible mistake or confusion. To merely identify himself as an "E & J man" or as a "man from E & J" could rightfully signify a representative of any one of five different concerns currently doing business under the name of E & J or EJ in Los Angeles alone [see Request for Admission 67, R. 448.] Also, it could signify a representative of any one of the long list of E & J concerns in Chicago [R. 498-500] or even a representative of E & J Lab in Kansas City, Missouri [R. 612.] Also, it could signify a representative of The E & J Company of Pennsylvania [R. 115] or the E & J Company of New England [R. 117] or E & J Resuscitator Company of Chicago [R. 118.] Other than being

exclusive distributors of plaintiff's products in certain territories, none of these last three concerns had any connection with the plaintiff.

Likewise a mere identification of a man as being an "E & J man" or a "man from E & J" could signify a representative of almost any one of the registrants of the prior registrations copies of which are included in the Record at 739 to 770, see particularly Reg. 81511 to Edmunds & Jones Mfg. Co.

Plaintiff's witness, Ken Healy, likewise testified that he introduced himself as

"I'm Ken Healy with E & J."

which was erroneously assumed to have signified that he was with Everest & Jennings [R. 620] rather than the plaintiff. Plaintiff's witness, Price testified that when he approached Mr. Persik and said

"'Mr. Persik, we handle the E & J resuscitator.'"

Persik said:

"'Mr. Price, I already have a deal on with E & J.'"

meaning Everest & Jennings [R. 641, 654.]

Plaintiff's witness, Armstrong, testified that he had been asked whether E & J Manufacturing Company, the plaintiff, was a subsidiary of Everest & Jennings, the defendant [R. 487.] However, he also testified that there had been instances of confusion between the plaintiff and plaintiff's competitor, Emerson presumably

"\* \* \* because we both use 'E' in the company name, they both start with an 'E'." [R. 495.]

Emerson is a competitor of plaintiff in the resuscitator business [R. 113.] Plaintiff's witness Garrett, testified

that when E & J Manufacturing Company's representative called the day after an Everest & Jennings representative had called at his place of business and discussed matters with his mother, Garrett was informed "that the E & J representative was here to see me." He erroneously assumed that the E & J representative was the same Everest & Jennings representative that had called the day before and he had no time to go over again the same matters that had been discussed the day before with Garrett's mother.

Comparing the facts of this case with the facts of *Sunbeam Lighting Co. v. Sunbeam Corp.*, 183 F. 2d 969 (CCA 9), it is manifest that if a sales representative of either party to that litigation introduced himself by saying "I'm from Sunbeam" there would be similar mistakes as to who he actually was affiliated with.

The significant part of all of this record is that nowhere does it appear that purchasers or prospective purchasers have in any way been confused, mistaken, or deceived by reason of the defendant having used the initials "E-J" on its wheel chairs, or from the defendant having advertised the initials "E & J" in advertising its wheel chairs. [See Requests for Admissions, 14, 15 and 16, R. 433-434.] This could hardly be because the defendant's full corporate name and address have always appeared in close proximity to the initials "E-J" wherever they have appeared [R. 388, 611, Deft. Ex. A.]

The statute, 15 USC 1114 provides:

"Any person who shall \* \* \* copy \* \* \* any registered mark in connection with the sale, or advertising of any goods \* \* \* on or in connection with which such use is likely to cause confusion

or mistake, or to deceive purchasers as to the source of origin of such goods \* \* \* shall be liable \* \* \*.”

The Trial Court in its oral opinion [R. 479] jumps to the conclusion that

“Confusion is not only possible, it is almost bound to occur in the future, and it has certainly occurred in the past \* \* \*.”

However, in so holding

(1) It ignores the question of whether defendant's “use (of the initials E & J *on its wheel chairs*) is likely to cause confusion or mistake, or to deceive purchasers as to the source of origin of such goods \* \* \*” or whether the confusion or mistakes made have been merely due to the similarity of the corporate names of the plaintiff and the defendant. Section 1114 of Title 15 provides a remedy only where the use of the trademarks is likely to cause confusion or mistake. It provides no remedy whatsoever if confusion or mistake results merely from the rightful use of one's own name which happens to be similar to the plaintiff's, or a rightful use of the initials thereof which, as testified to by plaintiff's witness Garrett [R. 556.]

“\* \* \* it is considerably easier for us to call them E & J than Everest & Jennings.”

(2) The Court also erred in assuming that in enacting the Lanham Act and particularly Title 15, Section 1114, Congress purported to change the enormous body of case law which preceded it to the effect that one had a right to use honestly and fairly his own name on his goods and abbreviations thereof; and

(3) The Court erred in assuming that Section 1114 is to be taken literally and at face value with the result that any confusion or mistake whatsoever that can in any way be possibly attributed to the defendant's use of the mark justifies relief. The Second Circuit Court of Appeals has held that this section did not purport to reverse the case law which preceded it but to merely codify it. Further, that the section is not to be taken literally.

*S. C. Johnson & Sons, Inc. v. Johnson*, 175 F. 2d 176, 81 USPQ 509, certiorari denied, 338 U. S. 860;

*American Chicle Co. v. Topps Chewing Gum Inc.*, 208 F. 2d 560, 99 USPQ 362.

This Court is apparently of the same opinion by reason of its quotation from and its citation of the *Johnson* case (*supra*) in *Sunbeam Furniture Corp. v. Sunbeam Corp.*, 191 F. 2d 141, 90 USPQ 43. As stated by this Court in *Sunbeam Lighting Co. v. Sunbeam Corp.*, 183 F. 2d 969, 86 USPQ 240:

“As to issue numbered ‘2’ the case is not solved by the simple finding as to whether defendant's use of the word ‘Sunbeam’ results ‘in confusion and likelihood of confusion.’ The answer to that question is material but circumstances not included in the framed statement must be taken into consideration.”

Furthermore, it is manifest that the section cannot be interpreted literally and at face value because it provides the same remedy with respect to “any registered mark” which would include those registrable only on the Supplemental Register which, under Title 15, Section 1091,

includes surnames, geographical names, and descriptive terms. In this respect, 15 USC 1114 is broader than Section 6 of the Trademark Act of 1920, which was interpreted in *Armstrong v. Nu-Enamel*, 305 U. S. 315, as restricted to "owners."

That is was not the intention of Congress in enacting the present Lanham Trademark Act to abandon the case law which preceded it is deduced from 15 USC 1115(a). This section after creating the *prima facie* presumption for registrations obtained under the Acts of 1881, 1905, and on the Principal Register of the present Act, specifically provides:

"\* \* \* but shall not preclude an opposing party from proving any legal or equitable defense or defect which might have been asserted if such mark had not been registered."

The present Act cannot be literally interpreted to the effect that any instances of confusion or mistake are sufficient but must be interpreted in the light of preceding case law and other circumstances.

In March, 1952, defendant filed an application to register "E-J" as applied to invalid wheel chairs. The application was allowed by the Examiner regardless of the coexistence of plaintiff's registration. Publication of defendant's mark was ordered and made in the Patent Office Official Gazette in the usual manner. Plaintiff instituted an opposition proceeding resulting in a decision being rendered by the Examiner of Interferences sustaining the opposition. A copy of the opinion was offered as Plaintiff's Exhibit 56 and rejected by the Trial Court [R. 254-257] but as the Trial Court at the same time stated that it would "take judicial knowledge of a

decision in the Patent Office" R. 256, it is believed that this opinion unduly influenced the Trial Court as to its conclusion that there was confusion within the meaning of the term as used in the Act.

An appeal was filed by the defendant from the decision of the Examiner of Interferences. This appeal on plaintiff's motion and over defendant's opposition was stayed because of the pendency of the present proceeding. It seems to be the discretionary practice of the Commissioner of Patents to stay proceedings in opposition proceedings if there is a civil action pending between the same parties involving the same subject matter. *Squirrel Brand Co. v. Barnard Nut Co.*, 101 USPQ 340. The Commissioner of Patents takes the view as stated therein:

“Simply stated, if the court concludes that this defendant (applicant) has the right to use its mark in commerce it has the right to register \* \* \*.”

Believing as we do that the defendant has the right to use its own initials on its own invalid wheel chairs and walkers, the defendant filed its counterclaim [R. 18] praying [R. 22]:

“That in accordance with the provisions of 15 USC 1119 this Court determine that the defendant has the right to use the trade-mark ‘E-J’ as applied to invalid wheel chairs, and consequently has the right to register the same in the United States Patent Office as applied to said goods, and that a decree or order to this effect be certified by the Court to the Commissioner.”

### Specification of Errors.

The Trial Court found that

“\* \* \* defendant's trade-mark originated by the gradual process of defendant's customers' spontaneous abbreviation of the firm name Everest & Jennings, Inc.” [Finding 8, R. 28.]

It also found

“The original mark 'Everest & Jennings' did not cause any confusion.” [Finding 11, R. 29.]

Further it found

“With a large segment of wheel chair users, the mark 'E-J' is understood to refer only to defendant's product and plaintiff's goods are unknown to those wheel chair users.” [Finding 15, R. 29.]

However, it also found

“There is a large sales area of products of plaintiff and defendant which are common to both parties. Confusion as to the origin of the goods is not only possible in such areas but is almost bound to occur in the future if such similar trade-marks are used, and it certainly has occurred in the past.” [Finding 15, R. 29.]

For this reason, the Trial Court concluded

“Defendant's use of the trade-mark 'E-J' has resulted in confusion as to the origin of the goods sold with said trade-mark applied thereon and is, therefore an infringement of plaintiff's registered trade-mark. \* \* \* Such infringement was without intent to infringe.” [Finding 13, R. 29; Conclusion of Law 4, R. 30.]

(Note: In its oral opinion, R. 479, the Trial Court said

“Confusion is not only possible, it is almost bound to occur in the future, and it has certainly occurred in the past; this without any intent on the part of the defendant company to *defraud*.”)

The conclusion reached by the Trial Court disregards the principle of law that anyone is entitled to use his own name on his products or any abbreviation thereof by which he is popularly known, and as long as he does so reasonably and honestly, it is immaterial whether some portion of the trade or public are confused or mistaken as long as they are not deceived. Without abandoning other errors this is the basis for the following errors expressed as statement of points [R. 701]:

“XI.

“The District Court erred in finding that the use of the trade-mark ‘E-J’ on wheel chairs has resulted in actual confusion to customers as to the origin of the goods sold with the trade-mark ‘E-J’ applied thereon.

“XII.

“The District Court erred in receiving in evidence mis-addressed letters and mis-addressed purchase orders without proper authentication of them as proof of confusion resulting from defendant’s use of the initials ‘E-J’ on its invalid wheel chairs and walkers.

“XIII.

“The District Court erred in failing to find that any confusion that has resulted is due entirely to the similarity in the names of the plaintiff and the defendant, the similarity in nicknames or abbreviations

thereof assigned to the plaintiff and the defendant by the trade and that confusion, if any, was not due to the applications of trade-marks by the parties to their respective goods.

“XV.

“The District Court erred in finding that defendant’s use of the trade-mark ‘E-J’ has resulted in confusion as to the origin of the goods sold with the trade-mark applied thereon and that it is therefore an infringement.

“XVI.

“The District Court erred in failing to find that defendant’s use of ‘E-J’ or ‘E & J’ on its goods (wheel chairs and walkers) was a legitimate, fair use of the initials of its own name and that as this was done honestly and fairly with no attempt to misrepresent or deceive or to cause mistake on the part of purchasers, defendant has committed no wrong.

“XVII.

“The District Court erred in assuming that any confusion or mistake regardless of its cause is sufficient to award the remedies under 15 USC 1114(1).

“XVIII.

“The District Court erred in finding that confusion as to the origin of the goods of plaintiff and defendant is not only possible but is almost bound to occur and has occurred in the past if this finding is attributed to the use of the trade-mark ‘E-J’ by the defendant to the defendant’s goods.”

### Argument.

A defendant has the right to use his own surname on the products that he manufactures and sells, and as long as he does so fairly and honestly, it is immaterial that he may interfere with and injure the business of another using the same name.

*Howe Scale Co. v. Wyckoff Seamans and Benedict*, 198 U. S. 118, 136;

*Horlick's Malted Milk Corp. v. Horlick*, 143 F. 2d 32 (CCA 7);

*Horlick's Malted Milk Corp. v. Horluck's, Inc.*, 59 F. 2d 13, 13 USPQ 296;

*Lerner Stores v. Lerner*, 162 F. 2d 160, 73 USPQ 524.

Whenever two persons having the same name or highly similar names engaged in the same or similar lines of business some confusion or mistake on the part of the careless or ignorant is almost bound to occur. However, as stated in *Howe Scale Co. v. Wyckoff*, 198 U. S. 118, 140:

“Having the right to that use, courts will not interfere where the only confusion, if any, results from a similarity of the names and not from the manner of the use. The essence of the wrong in unfair competition consists in the sale of the goods of one manufacturer or vendor for those of another, and if defendant so conducts its business as not to palm off its goods as those of complainant the action fails.

“As observed by Mr. Justice Strong in the leading case of *Canal Company vs. Clark*, 13 Wall. 311

‘Purchasers may be mistaken, but they are not deceived by false representations and equity will not enjoin against telling the truth.’ And by Mr. Justice Clifford in McLean vs. Fleming, 96 U. S. 245 ‘A court of equity will not interfere when ordinary attention by the purchaser of the article would enable him at once to discriminate the one from the other.’ And by Mr. Justice Jackson in Columbia Mills Company vs. Alcorn, 150 U. S. 460, ‘Even in the case of a valid trade mark the similarity of brands must be such as to mislead the ordinary observer.’ And see Coats vs. Merrick Thread Company, 149 U. S. 462; Liggett & Myers Tobacco Company vs. Finzer, 128 U. S. 182.

“We hold that, in the absence of contract, fraud or estoppel, *any man may use his own name, in all legitimate ways*, and as the whole or a part of a corporate name.” (Emphasis added.)

In *Canal Co. v. Clark*, 13 Wall. 311, 327:

“True it may be that the use by a second producer, in describing truthfully his product, of a name, or a combination of words already in use by another who just applied it, may have the effect of causing the public to mistake as to the origin or ownership of the product, but if it is just as true in the applications to his goods as it is of those of another who first applied it, and who therefore claims an exclusive right to use it, there is no legal or moral wrong done. *Purchasers may be mistaken, but they are not deceived by false representations and equity will not enjoin against telling the truth.* (Emphasis added.) (P. 328.)

“If the public are led into mistake, it is by the truth, not by any false pretense.”

As stated in *Schwartz v. Slenderella Systems of California, Inc.*, 271 P. 2d 857, 44 TM Rep. 1170, 102 USPQ 177, 178:

“To hold that confusion of source as to his products and the respondent’s services will be unlikely, Schwartz contends, is to ignore the factual instances of confusion shown by the evidence. He asserts that the trial court has negated the serious aspects of such confusion. Here the parties cater to the same class of the public, the argument continues ‘and it is not difficult to perceive that both appellant and respondent are competing for the same purchasing dollar.’

“Although factual instances of confusion may support a determination that confusion of the public is likely from the use of identical or similar trade names, *they do not compel that conclusion as a matter of law*. *Palmer v. Gulf Publishing Co.*, 79 F. Supp. 731, 738, 78 USPQ 349, 355; *Lerner Stores Corp. v. Lerner*, 162 F. 2d 160, 163, 73 USPQ 524, 526; *American Auto. Ins. Co. v. American Auto Club*, 184 F. 2d 407, 410, 87 USPQ 59, 61-62.” (Emphasis added.)

The principle that every man has the right to use his own name reasonably and honestly extends not only to his surname itself but to initials, nicknames, and to names by which he is generally known.

*H. Mueller Mfg. Co. v. A. Y. McDonaly and Morrison Mfg. Co.*, 132 Fed. 585, 586; on appeal, 183 Fed. 972, 973;

*Ida May Co. v. Ensign*, 20 Cal. App. 2d 339; *Elize Costume Co. v. Mme. Elize Inc.*, 206 App. Div. 503;

*D & W Food Corporation et al. v. Graham*, 286 P. 2d 77, 107 USPQ 24.

A second user of a person's own name or a derivation or an abbreviation thereof will be subject to stricter limitations on the use thereof when he is competing in the first user's own market than where he is the first to enter an entirely new even though closely related market.

*S. C. Johnson & Son, Inc. v. Johnson*, 116 F. 2d 427, 48 USPQ 82;

*Emerson Electric Mfg. Co. v. Emerson Radio*, 105 F. 2d 908, 42 USPQ 286.

It is only where there has been an element of concealment or suppression of the true identity of the accused infringer who uses his initials which are the same as those of another's trademark that relief has been granted.

*Great Atlantic & Pacific Tea Co. v. A & P Radio Stores*, 20 Fed. Supp. 703, 705;

*Radio Corporation of America v. RCA Rubber Co.*, 114 Fed. Supp. 462, 97 USPQ 536, 537;

*Cf. Alexander Young Distilling Co. v. National Distillers Products Corp.*, 40 Fed. Supp. 748, 51 USPQ 41.

No such concealment or suppression appears in the present case because the defendant's true full name and address always appears in close proximity to the initials "E-J" both on defendant's chairs themselves and in defendant's advertising [R. 377 and 388.]

In *Lerner Stores Corporation v. Lerner*, 162 F. 2d 160, 73 USPQ 524, the criterion for distinction was stated as follows:

"The element of false advertising or other conduct designed to mislead the public or cause confusion which was controlling in the cited cases, is absent here."

In *Horlick's Malted Milk Corporation v. Horluck's*, 59 F. 2d 13, 13 USPQ 296, this Court quoted with approval Mr. Justice Holmes in *Herring-Hall-Marvin Safe Co. v. Hall's Safe Co.*, 208 U. S. 554, 559, as follows:

“The principle of the duty to explain is recognized in *Howe Scale Co. v. Wyckoff, Seamans & Benedict*, 198 U. S. 118. It is not confined to words that can be made a trade-mark in a full sense. The name of a person or a town may have become so associated with a particular product that the mere attaching of that name to a similar product without more would have all the effect of a falsehood. *Walter Baker & Co. v. Slack*, 130 Fed. 514. An absolute prohibition against using the name would carry trade-marks too far. Therefore the rights of the two parties have been reconciled by allowing the use, provided that an explanation is attached. *Singer Mfg. Co. v. June Mfg. Co.*, 163 U. S. 169, 200, 204; *Brinsmead v. Brinsmead*, 13 Times L. R. 3; *Reddaway v. Banham* (1896), A. C. 210, 222; *American Waltham Watch Co. v. United States Watch Co.*, 173 Mass. 85, 87; *Dodge Stationery Co. v. Dodge*, 145 Cal. 380. *Of course the explanation must accompany the use, so as to give the antidote with the bane.*” (Emphasis added.)

Here, the parties to this litigation are unfortunate in that they have the same initials or nicknames as a multitude of other concerns employing the same initials throughout the United States. The defendant has not adopted the initials “E & J” for the purpose of acquiring some of plaintiff's business or depriving plaintiff of business. It is merely attempting to advertise in a convenient manner its own name. In supplying “the antidote with

the bane" there is little more that the defendant could do than to apply its full name on the underside of the footpads where its initials appear and applying a name plate to the wheel chairs carrying the defendant's full name and street address. The footpads are frequently swung up into vertical position to expose the name of defendant on the underside thereof. Furthermore, in its advertising it has closely associated with the display of the initials "E & J" its full name and address.

As it was the trade itself that commenced referring to the defendant's invalid wheel chairs as "E & J chairs" long before the defendant began a trademark use of these initials on the chairs themselves in 1946, it is manifest that this practice of referring to defendant's wheel chairs as "E & J chairs" will persist or continue whether defendant is enjoined from using the initials on the chairs themselves or not. The initials "E & J" are not and never can be a strong trademark. The distinction between strong and weak trademarks has been pointedly acknowledged by this Court in *Sunbeam Lighting Co. v. Sunbeam Corp.*, 183 F. 2d 969, 40 TM. Rep. 669, 86 USPQ 240.

There are too many other concerns throughout the United States who also use the initials "E & J" in their businesses. See also registrations at R. 739 to 770, inclusive.

Plaintiff's initials "E & J" have not been established to have acquired secondary meaning, and in the face of the common usage of these initials by others in their respective businesses, it is not apparent how plaintiff's initials could acquire secondary meaning unless restricted to the specific goods manufactured and sold by the plaintiff which are radically different from those of the defendant.

Misaddressed mail is of dubious evidentiary value in attempting to establish "confusion or mistake or deceit of purchasers."

*Vick Chemical Company v. Thomas Kerfoot X Co. Limited*, 80 F. 2d 73, 27 USPQ 393;

*Palmer v. Gulf Publishing Co.*, 79 Fed. Supp. 731, 78 USPQ 349, 355;

*Emerson Electric Mfg. Co. v. Emerson Radio*, 24 Fed. Supp. 481, 486, affirmed 105 F. 2d 908, certiorari denied, 308 U. S. 616;

*Time, Inc. v. T.I.M.E. Incorporated*, 102 USPQ 275, 123 Fed. Supp. 446;

*Kauffman v. Matczak*, 55 USPQ 238, 33 TM Rep. 18.

No one is shown to have ever purchased or received defendant's invalid wheel chairs under the confused or mistaken belief that he was acquiring goods he desired to purchase from the plaintiff. [Request for Admissions 14, 15, 16, R. 433-434.] In *Beechnut Packing v. P. Lorillard Co.*, 7 F. 2d 967 (CCA 3), the Court said:

"The only injury, real or fancied which the evidence indicates the plaintiff might sustain is that some of its customers are prejudiced against the use of tobacco and made inquiry to ascertain if it had embarked in the tobacco business, and threatened to stop dealing with it in case it had. This resulted from the similarity of trade marks on distinct and unrelated classes of merchandise. *But from confusion and injury caused by similarity of names the courts will not relieve. The defendant had a right to use its trademark if it did so reasonably and honestly. It is not the use, but dishonesty in the use that is condemned, \* \* \*.*" (Emphasis added.)

In *Chamberlain v. Columbia Pictures*, 186 F. 2d 923, this Court said:

“Establishment of a secondary meaning is necessary in order to sustain an action for unfair competition where the goods are entirely non-competing and unrelated.”

In *Sears, Roebuck & Co. v. All States Life Insurance Co.*, 246 F. 2d 161, 114 USPQ 19 (CA 5), the Court called attention to the restrictive effect given to the certificates of registration obtained under the Lanham Act as follows:

“\* \* \* Moreover, it may be appropriate to call attention to the restrictive effect given to the certificates of registration of the several marks of the appellant Sears because of the language of the statute itself. Section 1057(b) provides:

‘§ 1057. Certificates of registration—issuance and form. \* \* \*

‘(b) A certificate of registration of a mark upon the principal register provided by this chapter shall be *prima facie* evidence of the validity of the registration, registrant’s ownership of the mark, and of registrant’s exclusive right to use the mark in commerce *in connection with the goods or services specified in the certificate, subject to any conditions and limitations stated therein.*’

“15 U.S.C.A. § 1057(b).

“Considering here only the narrow question whether there was infringement of Sears’ trademarks, we do not come to the question whether there were other elements of unfair competition. As to the question of infringement, the statute itself seems to distinguish between cases in which the alleged infringer uses the mark with a different product and

those in which he uses it on a competing article, for the marks as such do not carry the statutory presumptions of registrant's exclusive right to use except *as to the goods actually specified* in each certificate of registration. None of these, included insurance. They all related to articles of merchandise."

(Emphasis quoted.)

Here, the effect of the appealed judgment is to require the defendant to discontinue the use of the initials "E & J" as a trademark. This in legal effect is forcing the defendant to make a legal abandonment of the mark "E-J" as applied to wheel chairs. As the plaintiff has lost no sales it is not apparent how this could benefit the plaintiff unless the plaintiff or its beneficial owner, American Hospital Supply Corporation, should embark in the wheel chair business. Plaintiff's engaging in the invalid wheel chair business is no mere unsubstantiated fear on the part of the defendant. Emery S. Beardsley, President of the plaintiff, testified in January, 1954, as follows [Defendant's Request for Admissions 63, R. 446]:

"XQ411. I just want to test your memory. Was this discussion or mention of the possibility of going into the wheel chair business in any way participated in by the officials or anybody representing American Hospital Supply Corporation?

A. The only ones present were myself and Mr. Bivens, he and I.

XQ412. Just you and Mr. Bivens discussed it?

A. We were discussing potential new products for E & J Manufacturing Co., because we have lots of room over there and we are going into more new products just as fast as we can and one of the new suggested items by Mr. Bivens was wheel chairs for invalids."

At the same time he also testified as follows [Request for Admissions 64, R. 446, 447]:

“A. I have already said that there is a difference between wheel chairs and the product that E & J Manufacturing Co. manufactures now. I am thinking of the future, the new product that E & J may want to make. Suppose we want to make wheel chairs and decide to do it.

XQ324. And suppose you call them ‘E & J’; is that it?

A. *Well, we should be able to use our own trade-mark on wheel chairs, in my opinion.* I think it is a very unethical thing for Everest & Jennings to be using ‘E & J’ since we have been using it since about 1929 as a trade-mark.

XQ325. And you contemplate going into the wheel chair business and identifying them as E & J, is that it?

A. I didn’t say that. I don’t know what the future holds further.

XQ326. Well, then, the real purpose of this proceeding is to enable you to do that if you want to do that, is that it?

A. What proceeding do you mean?

XQ327. This Opposition proceeding.

A. *I would say that is one of the purposes, yes.”*

And as follows [Request for Admission 65, R. 447]:

“The Witness: If E & J Manufacturing Co. were manufacturing wheel chairs, it would certainly want to apply its trade-mark ‘E-J’ to wheel chairs.”

Emery S. Beardsley, who gave the above testimony is

“\* \* \* chairman of the board of Don Baxter, Inc., of Glendale, California; president and a director

of E. & J. Manufacturing Company of Burbank, California, and a director of American Hospital Supply Corporation, Evanston, Illinois.” [R. 453-454.]

As American Hospital Supply Corporation has now acquired an invalid wheel chair manufacturing company and is engaged in the manufacture and sale of invalid wheel chairs, it might continue to do so through American Hospital Supply Corporation or through E & J Manufacturing Company which it owns through Don Baxter, Inc. [Request for Admissions 19, R. 435.] If it should identify such wheel chairs by defendant's trademark—that the Trial Court would force defendant to abandon—a most unfair situation could be created comparable to that of *J. Treager v. Gordon-Allen, Ltd.*, 71 F. 2d 766 (CA 9).

It has many times been said that the law of trademarks is only a part of the law of unfair competition.

*Hanover Milling Co. v. Metcalf*, 240 U. S. 403; *S. C. Johnson & Son, Inc. v. Johnson*, 175 F. 2d 176, 81 USPQ 509, certiorari denied 388 U. S. 860.

As the greater (the law of unfair competition) includes the less (the law of trademarks) and the Trial Court has found the defendant guilty of no unfair competition, his finding of trademark infringement is to that extent inconsistent. Unfair competition can undoubtedly exist without trademark infringement, but we know of no case to the effect that trademark infringement can exist in the absence of unfair competition. *Aunt Jemima Mills Co. v. Rigney*, 247 Fed. 407, might appear to be that way, but in discussing the case in *S. C. Johnson & Son Inc.*

*v. Johnson, supra*, the law of registered trademarks was stated to merely have been extended to

“\* \* \* make the protection of the new right coextensive with the law of unfair competition as it was in 1946 \* \* \*.”

While it is true that there is a sales area of products of plaintiff and defendant which are common to both parties as found by the Court in Finding 15 [R. 29], to wit, hospitals and institutions, it should be borne in mind that sales of the plaintiff's products are made only after the most discriminating scrutiny by intelligent doctors. [R. 135.] These people who have the power of accepting or rejecting plaintiff's apparatus certainly possess an equal power of discerning that defendant's wheel chairs do not come from the same source as plaintiff's resuscitators and oxygenators.

We think the Trial Court definitely exceeded its authority and abused its equitable discretion not only in enjoining the defendant from continued use of the trademark “E-J” or “E & J” but in also requiring the defendant to

“\* \* \* immediately circularize to his (its) present customer list and advise them of what other name it intends to use in the marketing of its products and state that it is withdrawing from use the trade-mark ‘E-J.’” [R. 32.]

There is no requirement in law that a manufacturer or seller of merchandise use any trademark whatsoever. Furthermore, it is a matter of common knowledge that the selection and adoption of a trademark frequently

requires thought, search to determine availability, and other considerations involving time. To require the defendant to

“\* \* \* immediately circularize his present customer list and advise them of what other name it intends to use in the marketing of its products  
\* \* \*”

not only exceeds the authority of the Court, but is an abuse of its equitable discretion.

### Conclusion.

Here, the defendant is in no way endeavoring to gain any benefit at the expense of the plaintiff. It is attempting to sell its own goods honestly and fairly under its own name which unfortunately has the same initials as those of the plaintiff and a multitude of other concerns scattered throughout the country. As it is easier to refer to the defendant by its initials rather than by its full corporate name, mistakes have occurred and may occur in the future. These mistakes may continue to occur for this reason, even should the defendant discontinue its use of “E-J” as its trademark because of the common usage of the term in the trade. The trade cannot be enjoined from continuing to refer to the defendant and its products by the term “E-J” or “E & J.” These mistakes are of no advantage to the defendant and should be regarded as one of the inherent penalties involved in the plaintiff’s selection of a weak and commonly used mark.

It is respectfully urged that the District Court should be reversed as to its holding of trademark infringement. It should further be held that the defendant not only has the right to use its own name but also initials and abbreviations thereof by which it is popularly known. Consequently, it is urged that it be held that the defendant is entitled to use "E-J" on its products and to register the same in the United States Patent Office as applied thereto.

Respectfully submitted,

FRED H. MILLER,

ALLAN D. MOCKABEE,

By FRED H. MILLER,

*Attorneys for Everest & Jennings, Inc.*





## APPENDIX.

### LIST OF EXHIBITS.

Plaintiff's Exhibit No.	Identified	Offered and Received or Rejected
1	37	37
2		
3		
4	44	46
5	47	48
6	44	46
7	48	49
8	49	50
9	53	53
10	56	56
11	57	57
12	60	60
13	61	61
14	62	63
15	64	64
16	64	64
17	52	52
18	69	69
19	69	69
20	59	
21		
22		
23		
24		
25	73	73
26	74	74
27	75	75
28	75	75
29	75	75
30	77	77
31	84	85
32	84	84
33	83	84
34	83	83
35	82	82

Plaintiff's Exhibit No.	Identified	Offered and Received or Rejected
36	85	85
37	85	86
38	86	87
39	87	90
40	101	102
41	96	97
42	100	100
43	100	100
44	100	100
45	100	100
46	105	105
47	111	111
47-A	147	147
47-B	465	466
47-C	465	466
48	203	
49	226	228
50	226	228
51	235	253
52	235	253
53	235	254
54	235	254
55	251	254
56	254	256
57	258	477
58	262	264
59	262	264
60	264	264
61	310	477
62	282	358
63	282	477

Exhibit No. Plaintiff's	Identified	Received or Rejected Offered and
64	282	283
65	283	358
66	284	284
67	284	358
68	284	285
69	285	358
70	285	286
71	290	292
72	295	295
73	324	324
74	417	417
75	418	418
76	419	419

Defendant's Exhibits	Identified	Offered and Received or Rejected
A	188	400
B	358	358
C	358	359
D	359	359
E	387	387
F	390	391
G	394	394
H	394	394
I	397	397
J	400	403
K	403	404
L	403	404
M	421	428
N	427	428
O	452	452
P	452	453

